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Applicant(s): Flickinger, et al.

Application No: 10/706,748

Filing Date: November 12, 2003

Attorney Docket No: 17511 C

Title: PLUGGABLE MODULE AND
RECEPTACLE

Art Group: 2839

Confirmation No. 7557

Examiner: Dinh, Phuong K.

CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being transmitted via facsimile to 571 273 8300 on
April 24, 2006.


Stephen J. Driscoll

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO THE FINAL OFFICE ACTION DATED FEBRUARY 22, 2006

Dear Sir:

This Request for Reconsideration is being filed timely in response to the final Office Action dated February 22, 2006, in connection with the above-identified patent application. The Commissioner is hereby authorized to charge any fees which may be required, any deficiencies that may arise, and to credit any overpayment which may be owed to Applicant in connection with this action and application in general to Deposit Account No. 19-5425.

Remarks begin on page 2 of this paper.

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REQUEST FOR RECONSIDERATION

Although the Examiner provided new grounds for rejection, she nevertheless maintained her rejection of Claims 26, 38-40, and 42-43. Specifically, she finds these claims unpatentable over *Poplawski* (U.S. Patent No. 5,879,173) in view of *Smith* and further in view of *Burgmann* (U.S. Patent No. 4,801,924). She states that "*Poplawski* discloses the claimed invention except for a back wall that provides enclosure for the PCD pads." She states, however, that "it would have been obvious ... to modify *Poplawski* to provide the back walls taught by *Smith* and *Burgmann* so as to provide for a simpler housing design." In response to Applicants' previous arguments that *Smith* was non-analogous art, she states that these arguments "have been considered but are moot in view of the new grounds of rejection."

In reply, Applicants respectfully submit the Examiner reconsider her rejection of Claims 26, 38-40, and 42-43.

The rejection is based upon a combination of non-analogous prior art.

Although the Examiner indicated that she is maintaining the rejection based upon new grounds thus obviating the Applicants' previous arguments with respect to *Smith* being non-analogous art, she nevertheless relies on *Smith* as a secondary reference. Although she also relies on *Burgmann*, it, like *Smith*, is non-analogous prior art. "To rely on a reference as a basis for rejection of an applicants' invention, the reference must either be in the field of the applicants' endeavor or, if not, then must be reasonably pertinent to the particular problem with which the inventor was concerned." M.P.E.P. §2141.01(a) citing *In re Oetiker*, 977 Fed 2nd 1443 (Fed. Cir. 1992). In this case, *Burgmann* is neither in the applicants' field, nor is it reasonably pertinent to the problem with which the inventors were concerned.

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The field of the applicants' endeavor is clearly set forth in the claims themselves. As amended with the submission of the RCE and further herewith, the claims in question are directed to a *telecommunications transceiver* module. The applicants' field of endeavor is also set forth in the Field of Invention:

The present invention relates generally to electronic connector systems and, more specifically, to low-profile connector systems for pluggable electronic modules, such as transceiver modules for high speed fiber optical and copper communications.

Therefore, the field of the applicants' endeavor for the claims in question is clearly a telecommunication transceiver.

On the other hand, *Burgmann* is related to a wireless security system as set forth in the Field of Invention. (Col 1, lines 7-8). Indeed, the transmitter module disclosed in *Burgmann* is wireless and does not even interface with optical or electrical plug connectors. Therefore, since *Burgmann* relates to a wireless security system and not to a transceiver module for telecommunications, it is outside the field of the applicants' endeavor.

Since *Burgmann* lies outside the field of applicants' endeavor, the issue becomes whether the references are reasonably pertinent to the particular problem with which the inventor was concerned. Here, the claimed invention is aimed at a telecommunication transceiver module which facilitates miniaturization and EMI protection. More specifically, the claimed invention is directed to a transceiver module that "[facilitates miniaturization and high operating frequencies [characteristic of telecommunications] by effectively shielding EMI emissions to eliminate leaks" (App. Summary of Invention). To this end, the transceiver module of the claimed invention comprises walls to shield the circuit board it contains and prevent EMI emissions. The transceiver module also comprises, in a preferred embodiment, grounding tabs to channel EMI to ground.

It is inconceivable to Applicants why one skilled in the art would look to *Burgmann* to solve a problem of configuring a transceiver module which is

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suitable for miniaturization and EMI reduction in the telecommunications field. *Burgmann* is directed to a wireless security system for sensing the status of various security detectors used in home security. The transmitter is programmed with information by a programming unit, and then removed from the unit and inserted in a particular sensor. When the sensor goes into an alarm condition, it causes the transmitter to transmit an appropriate message to a central monitor. *Burgmann* is purportedly directed to programming the transmitter such that, while it is in transit between the programmer and the sensor, it does not transmit and thus diminish its low power voltage source and lose vital memory. The transmitter is contained in a modular housing for easy transport and insertion into both the programming and sensing units.

Burgmann does not mention a transceiver module for telecommunications--much less the need to miniaturize and control EMI. To the contrary, *Burgmann* is directed to a *transmitter* and, thus, is aimed at *generating* electromagnetic radiation rather than reducing it. There is not a scintilla of evidence suggesting that one skilled in the art would turn to *Burgmann* to solve the problem of designing a telecommunication transceiver for miniaturization and EMI reduction.

Therefore, since *Burgmann* is not in the field of the claimed invention, and since one skilled in the art would not find the reference reasonably pertinent to solve the problem with which the inventor was concerned, *Burgmann* is not analogous art. Accordingly, it should be removed and the claims allowed.

There is no motivation to combine the transceiver of *Poplawski* with the module housing as taught by *Smith* and *Burgmann*.

The Examiner has stated that one would be motivated to modify the transceiver of *Poplawski* to have the back wall as taught by *Smith* and *Burgmann* so as to "provide for a simpler housing design." Such a rejection, however, is based on hindsight rather than motivation found within the cited art.

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Indeed, there is no motivation to modify the transceiver of *Poplawski* to have the housing as taught by *Burgmann* or *Smith* since such a modification would render the module of *Poplawski* unsuitable for its intended purpose. It is well established in US patent law that there can be no motivation to modify a reference if that modification would render the reference unsuitable for its intended purpose.

Poplawski is directed to an optoelectric transceiver having a potted circuit board. The housing of the transceiver functions as a potting box for containing the potting material as it is poured over the circuit board. Thus, the housing of *Poplawski* is intended only to house the circuit board but also to contain the potting material while the circuit board is being potted within the housing. (See abstract).

Modifying the module of *Poplawski* to have a rear wall as disclosed in *Burgmann* or *Smith* for containing the module connector would destroy the potting box. Specifically, if the housing were modified so as to contain the module connector, the rear wall must contain an opening to provide access to the module connector. This opening, however, would compromise the potting box as the potting material would be free to flow out. Additionally, if the circuit board and module connector were contained within the same housing, then the potting material would cover, not only the circuit board, but also the module connector as well. This would ruin the module connector. Thus, modifying the housing of *Poplawski* so that the back wall contains the module connector would destroy the intended purpose of *Poplawski*. Accordingly, there can be no motivation to do so. Without motivation, the rejection should be withdrawn and the claims allowed.

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In light of the above remarks, an early and favorable response is earnestly requested.

Respectfully submitted,



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